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IN THE
Supreme Court of the United States

October Term, 1938.

No. 441.

THE ELECTRIC STORAGE BATTERY CO.,

Petitioner,

v.

**GENZO SHIMADZU and NORTHEASTERN
ENGINEERING CORPORATION,**

Respondents.

**Petition for Rehearing on Behalf of Petitioner, The
Electric Storage Battery Co.**

HUGH M. MORRIS,

Attorney for Petitioners.

A. B. STOUGHTON,

A. F. KWIS,

E. S. W. FARNUM,

ALEXANDER L. NICHOLS,

Counsel for Petitioner.



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GENZO SHIMADZU AND NORTHEASTERN ENGINEERING CORPORATION,

Respondents.

PETITION FOR REHEARING ON BEHALF OF PETITIONER, THE ELECTRIC STORAGE BATTERY CO.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Petitioner, The Electric Storage Battery Co., respectfully petitions the Court for a rehearing¹ in the above-entitled cause, for the following reasons and upon the following grounds.

¹ Judgment of this Court was entered herein on April 17, 1939. Three questions (opinion, p. 2) presented by the Petition for the Writ of Certiorari, were passed upon by this Court in its consideration and decision of the case. The first and second of such questions, relating respectively to priority of invention and abandonment, were decided adversely to the contentions of petitioner. The third of such questions, relating to public use, was decided adversely to respondent. This petition is addressed solely to the decision of this Court upon the question of priority of invention.

I.

The Patent Statutes of the United States, at Least Since the Enactment of Section 15 of the Patent Statute of 1836, have Disclosed and Established a Congressional Policy of Favoring Him Who Makes an Invention in This Country as Against One Who Earlier Makes the Same Invention Abroad But Does Not Patent or Publish the Foreign Invention Before the Like Invention Is Made Here. Yet, the Decision of This Court in the Case at Bar Would Seem to Reverse the Century Old Policy So Established by the Congress.

By Section 15 of the Patent Statute of 1836, now R. S. 4923, the Congress established the policy of favoring, to the extent there provided, one who makes an invention in this country as against one who earlier made the same invention abroad if the invention so made abroad was not patented or published before the same invention was made in this country.

This Court recognized this policy of the Congress and its Statutes in **Gayler v. Wilder**, 10 Howard 477, 497.

By the Patent Statute of 1870 interpolating the words "in this country" in what is now R. S. 4886, the Congress did not change the existing policy evidenced by Section 15 of the Patent Statute of 1836 and by **Gayler v. Wilder**, but it enlarged and extended the then existing policy favoring inventions made here as against those made abroad.

The Congress further recognized the aforesaid preferential character of the Patent Statutes by the amendment of 1903 to R. S. 4887.

Again the Congress recognized the long existing policy of the Statutes so favoring inventions made in this country by the provisions of the Nolan Act.

This Court by its decision in the case at bar seems, however, to have reversed the century old preferential character of the Patent Statutes, recognized by this Court in *Gayler v. Wilder*, and to have given preference to him who made an unpatented and unpublished invention abroad instead of to him who later made the same invention in this country.

True, this case is not, strictly speaking, a contest between rival inventors yet, in effect, it is such a contest, for, the American public here stands in the shoes of the inventor of the process which was in public use by petitioner in June 1921. Petitioner is a member of that American public.

Were this proposition not sound an invention abandoned by one inventor would pass to and enure to the benefit of another inventor instead of to the American public. That an abandoned invention enures to the benefit of the American public and not to some other inventor was established by this court in **Corona Co. v. Dovan Corp.**, 276 U. S. 358, 384-385.

That a patent granted under R. S. 4886 cannot be held to be void because the invention or discovery, or any part thereof was known or used in a foreign country before his (patentee's) invention or discovery thereof is established by R. S. 4923.

If a person having the inchoate right to obtain a patent under R. S. 4886 renounces that right the right to the invention vests in the public.

The invention made in this country was in public use in this country in June 1921 by a member of the American Public. By the decision of this Court the right of the public to the use of that invention was not only denied because of Shimadzu's knowledge and use thereof in Japan in 1919 but Shimadzu was held to be entitled to a patent therefor.

This would seem to give to the patent statutes a preferential character in favor of inventions made abroad as against the contrary century old statutory preference in favor of inventions made in this country if the earlier invention made abroad had not been patented or published.

II.

In Holding That in an Infringement Suit by the Owner of a Patent for an Invention, Made But Not Patented or Published Abroad, to Restrain an Innocent Use, the Inception of Which Antedates the Application for the Patent, and the Importation of the Foreign Made Invention into This Country, the Plaintiff May Prove That His Actual Date of Invention Was Earlier Than the Asserted Infringing Use, This Court, It Is Believed, Failed to Give Effect to the True Purpose and Intention of the Congress in Adding, by the Patent Act of 1870², the Words "in This Country" Immediately Following the Words "Not Known or Used by Others", in What Is Now R. S. Sec. 4886.

Prior to the Patent Act of 1870, invention or want of invention, was made to depend³ upon whether or not the thing alleged to have been invented was "known or used by others before his or their invention or discovery thereof", the other conditions and requirements of the Statute being fulfilled.⁴ As interpreted by the Courts⁵ the earlier Statute was held to require that an invention, to be

² 16 Stat. 198, Sec. 24.

³ Patent Act of 1836, 5 Stat. 117, Sec. 6.

⁴ No question as to such other requirements or the construction of the Statute in respect thereof is here involved.

⁵ Sewell v. Jones, 91 U. S. 171, 179-180; Pennock v. Dialogue, 2 Peters 1, 20-22; Dawson v. Follen, Fed. Cas: 3670.

novel, must have been first in point of time as against knowledge and use thereof existing anywhere in the world. By the Patent Act of 1870, however, knowledge and use, to deprive an invention here made of the quality of novelty, must be knowledge or use possessed or exercised by "others in this country".*

Furthermore, it would seem manifest that by the amendment of the Statute, effected by the Patent Act of 1870, the Congress intended merely to make the Statute, now Section 4886, expressly conform to that to which had theretofore been declared ⁶ by this Court on the basis of Sections 6 ⁷ and 15 ⁸ of the Patent Act of 1836, to be the law.

But indeed, the Statute became, by virtue of the amendment of 1870, even more comprehensive in effect than was the combined effect of Sections 6 and 15 of the Patent Act of 1836, in that Section 15 gave protection against prior unpatented and unpublished knowledge and use of the invention in a foreign country only to one who was a patentee in this country and who, at the time of his invention or discovery, believed himself to be the first inventor; whereas, the right to the status of first inventor given by the Patent Act of 1870 to one who independently made his invention or discovery in this country, was not dependent upon proof of his belief as to whether or not he was then the first inventor, but was, as to unpatented and unpublished knowledge and use abroad, absolute and unconditional. Insofar as invention depends upon knowledge and use of the thing invented by others, the provisions of the Patent Act of 1870 have not since been altered. It therefore appears that the provisions

* Emphasis throughout petition is counsels'.

⁶ Gayler v. Wilder, 10 How. 477, 497.

⁷ Now R. S. Sec. 4886.

⁸ Now R. S. Sec. 4923.

of R. S. Sec. 4923, so enlarged and extended, have now been incorporated in R. S. Sec. 4886.

The inevitable consequence of the amendment of the Statute effected by the Patent Act of 1870, which has been carried into R. S. 4886, is, we submit, to give to one in this country (whose identity need not even be known⁹), "who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvements thereof, not known or used by others in this country before his invention or discovery thereof", the status of first inventor in all cases, and to his invention or discovery, the status of novelty, irrespective of prior knowledge or use in a foreign country of the thing so independently invented or discovered in this country.

That status is here applicable to the inventor of petitioner's process and to the process itself, for it is that very process (so established by the decrees of infringement entered by the Courts below), which was in public use in this country in June, 1921, many months prior to any knowledge or means of knowledge in this country of Shimadzu's earlier knowledge and use thereof in Japan.

That such first inventor of petitioner's process did not apply for or receive a patent for his invention cannot, it is submitted, deprive him of his status as first inventor or destroy the status of novelty accorded by the Statute to his invention. He became the first inventor and his invention acquired the status of novelty when he met the requirements of R. S. Sec. 4886, which alone need be satisfied to create that status.

The Statute does not make that right and status of the first inventor forfeit because of a failure to apply for a pat-

⁹ *Milburn Co. v. Davis etc. Co.*, 270 U. S. 390, 401.

ent or because of a dedication of the invention to the public. The right conferred by the Statute upon the first inventor to obtain a patent for his invention may, of course, become forfeited through failure or delay in making timely application. But such failure or delay inures solely to the benefit of the American public and confers upon an inventor who thereafter seeks to bring the same invention within the scope and field of operation of the Patent Statutes of this country no right to obtain a patent for that of which he was not, in contemplation of the Patent Laws of the United States, the first inventor.¹⁰

To require, as the Court's construction of the Statute seems to do, that one making an invention in this country shall, to establish his right of priority and novelty as against an earlier though unpatented and unpublished invention made abroad, patent his invention or apply for a patent therefor, would seem to interpolate into the Statute a further condition precedent to the status of first inventor not found therein.

¹⁰ In *Corona Co. v. Dovan Corp.*, 276 U. S. 358, 384-385, this Court said:

"If Kratz discovered and completed, as we are convinced that he did, the first use of D.P.G. as an accelerator in making vulcanized rubber, he does not lose his right to use this discovery when he chooses to do so, for scientific purposes or purposes of publication, because he does not subsequently sell the rubber thus vulcanized, or use his discovery in trade, or **does not apply for at patent for it.** . . . It is doubtless true that Kratz, by his course in respect to his discovery as to the use of D.P.G., has abandoned any claim **as against the public** for a patent, but that is a very different thing from saying that it was abandoned as against a subsequent discoverer or patentee."

Petitioner does not ask the Court to write into the Statute the words "in this country" after the words "before his invention or discovery thereof". The Congress, we believe has already made clear, by the amendment of 1870, that one who makes an invention in this country is the first inventor as against one who made the same invention earlier abroad but who had not patented or published his invention or brought it to this country prior to the date of the invention made here. But with far more reason, we submit might those words, if necessary, be supplied, than that there should be read into the Statute a provision forfeiting the rights of priority and novelty conferred by the Statute upon one making an invention in this country, unless a patent for the American invention be applied for.

III.

By Its Construction of R. S. 4886 in the Instant Case, the Court, It Is Believed, Has Inadvertently Overlooked the Construction Put Upon That Statute by the Congress Itself, upon Which Petitioner's Contention Here Made Is in Large Measure Based.

Thus, by the Act of March 3, 1903,¹¹ the Congress amended R. S. Sec. 4887 by adding thereto a new provision giving to an application for patent for an invention or discovery filed in this country by any person who has previously regularly filed an application for the same invention or discovery in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention or discov-

¹¹ 32 Stat. 1225.

ery was first filed in such foreign country, provided the application in this country is filed within twelve months from the earliest date on which any such foreign application was filed.

It is true, as pointed out in the decision of the Court (opinion, p. 4), that the purpose of that Statute "is to permit the filing of applications for the same invention in foreign countries and in the United States" and that the amendment thereof by the Act of 1903 had for its purpose the fulfillment of reciprocal agreements with foreign countries. **But that very fact serves to establish, it is believed, that without such enabling amendment the Patent Statutes of this country conferred upon foreign inventors no right to take back the date of their inventions, as against knowledge and use thereof existing in this country, even by proof of prior applications filed in a foreign country.** And indeed if such were not the effect of the then existing patent laws, there would appear to have been no necessity whatever for so amending R. S. 4887.

Again, in Section 6 of the Nolan Act¹² the Congress provided:

"Where an invention was made by a person while serving abroad, during the World War, with the forces of the United States, civil or military, the inventor thereof shall be entitled, in interference and other proceedings arising in connection with such invention, to the same rights of priority with respect to such invention as if the same had been made in the United States. (Mar. 3, 1921, c. 126 § 6, 41 Stat. 1314)."

If foreign inventors had been deemed by Congress to be entitled under the then existing law to the same rights of priority with respect to inventions made abroad as if the

¹² Act of March 3, 1921, 41 Stat. 1314; 35 USC Sec. 85.

same had been made in the United States, the same rights would manifestly have been available to persons making inventions abroad while serving during the World War with the forces of the United States, civil or military, and Section 6 of the Nolan Act would have been a clear act of supererogation.

That the Congress did not construe the then existing law as giving to anyone making an invention in a foreign country the same rights of priority in interference and **other proceedings** as if the same had been made in the United States, is, we believe, demonstrated by the Nolan Act.

The Court holds (opinion, p. 6) that the Congress has, by its failure to amend R. S. 4886 in the light of inferior Court decisions permitting a foreign inventor to establish priority as against unpatented knowledge and use of the same invention in this country by proof of an earlier actual date of invention abroad, impliedly approved such decisions.

It is submitted, however, that the failure of the Congress to amend R. S. Sec. 4886 subsequent to such inferior Court decisions, is squarely met and overcome by the construction which the Congress has itself put upon that section in the amendment of R. S. Sec. 4887 by the Act of March 3, 1903, and by the Nolan Act, and that the true explanation of the failure of the Congress further to amend R. S. 4886 lies in the fact that the Congress itself believed that it had already made effective such amendment (in conformity with the decision of this Court in *Gayler v. Wilder*, 10 How. 477, 497) in and by the Patent Act of 1870.

WHEREFORE, petitioner prays that this petition for rehearing be granted and that the mandate of this Court be withheld pending the determination thereof by this Court,

and for such further time as the Court may order in the event this petition shall be granted.

Respectfully submitted,

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Counsel for Petitioner.

I, Hugh M. Morris, counsel for The Electric Storage Battery Co., the petitioner above named, do hereby certify that the foregoing petition for rehearing is in my opinion well founded in law and that it is presented in good faith and not for delay:

May 12, 1939.

HUGH M. MORRIS.